

## REMARKS

Claims 1 and 3-31 and 33-44 are pending in this application and stand rejected.

### Reopening of Prosecution/Reinstatement of Appeal

Applicants would note for the record that this Office Action was issued to reopen prosecution in response to Applicants' Pre-Appeal Brief Statement, notwithstanding that the Examiner has maintained the same 103 rejections. Applicants retain their right to reinstate the Appeal in this Action without further cost in the event that the Examiner issues a Final Office Action. Applicants respectfully request reconsideration of the claim rejections based on the following remarks.

### Claim Rejections – 35 U.S.C. § 103

The following claim rejections have been asserted under 35 U.S.C. § 103(a):

Claims 1, 3-5, 8-11 and 33 stand rejected as being unpatentable over U.S. Patent No. 5,999,970 to Krisbergh in view of U.S. Patent No. 6,026,086 to Lancelot et al.

Claims 6-7 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of U.S. Patent 6,141,356 to Gorman;

Claims 12-14 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of U.S. Patent No. 5,561,703 to Arledge;

Claims 15-16 stand as being unpatentable over Krisbergh in view of Lancelot and further in view of U.S. Patent No. 5,991,596 to Cunningham;

Claims 17-18 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of U.S. Patent No. 6,320,941 Tyroler;

Claims 19-22, 26-28, and 34-35 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of U.S. Patent No. 6,263,501 to Schein;

Claims 23-24 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of Schein and further in view of U.S. Patent No. 5,812,931 to Yuen;

Claim 25 stands rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of Schein and further in view of Yuen and further in view of Arledge;

Claims 29-31 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of Schein and further in view of Cunningham;

Claims 36-39 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of U.S Patent No. 6,285,407 to Yasuki;

Claim 40 stands rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of Yasuki and further in view of Arledge;

Claim 41 stands rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of Yasuki and further in view of Cunningham;

Claims 42-43 stand rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of Yasuki and further in view of Tyroler; and

Claim 44 stands rejected as being unpatentable over Krisbergh in view of Lancelot and further in view of Yasuki and further in view of Schein.

With regard to the obviousness rejections, Applicants maintain that at the very least, the obviousness rejections of claims 1 and 36 are based on impermissible hindsight reasoning where the Examiner has simply combined different teachings from the references in an attempt to establish the claim elements without establishing proper motivation for combining the teachings, for at least those reasons previously stated in the Pre-Appeal Statement and reiterated herein below.

With respect to claim 1, Applicants respectfully submit that the combination of Krisbergh and Lancelot does not disclose or suggest various features of claim 1, for example:

... a first communication system, operatively coupled to a television set, comprising a first RF transceiver unit and a first data processing unit for generating at least one information signal ... a wireless signal transfer network for wirelessly transferring signals including the at least one information signal ... a second communication system operatively coupled to the wireless transfer network, comprising a second RF transceiver unit and a second data processing unit for receiving and processing the at least one information signal and ... generating at least one return information signal and providing the at least one return information signal to the wireless signal transfer network, *wherein the at least one information signal and the at least one return information signal are independently transmitted from a television signal.*

With respect to claim 1, Applicants respectfully submit that the combination of Krisbergh and Lancelot does not disclose or suggest the above features of claim 1. For example, the primary reference Krisbergh is directed to a system and method for providing access to the Internet through a cable television distribution system (see, Col. 1, lines 10-13). The Examiner acknowledges, at the very least, that Krisbergh does not disclose a return signal is independently transmitted from a TV signal (see, e.g., page 6 of the Final Action).

The Examiner relies on Lancelot in this regard. In particular, Examiner contends (without explanation) that Lancelot discloses (FIG. 2, Col. 4, lines 25 – COL. 5, line 17) that return data is independently transmitted from a TV signal (see page 7 of the Final Action). It is respectfully submitted that the Examiner's reliance on Lancelot is misplaced.

To begin, Lancelot discloses in FIG. 2 a primary station (105) which is a shared (trunked) device in a central location that provides services to many subscribers and users. The primary station (105) sends data to a plurality of secondary stations (110) that are located within the

users' homes (including telephones, PCs, video displays, etc.) via a HFC (hybrid fiber coaxial) communications system (103). Lancelot discloses that a TV signal is transmitted with other signals (via combiner (104)) on the HFC communications system (103), and that CACS (cable access signaling) is used for transmission and reception of data, etc. over communication channel (103) at radio frequencies compatible with cable television CATV networks (see, Col. 4, lines 45-66, and Col. 5, lines 45-55).

In this regard, Lancelot is yet another example of using communications over low bandwidth cable networks, which the inventors distinguish from the claimed inventions (see, e.g., pages 1 and 2 of Applicants' specification. In this regard, the relevance of Lancelot is questionable at best with respect to the claimed inventions.

Moreover, the Examiner has not demonstrated proper motivation for combining Krisbergh and Lancelot. The Examiner contends that it would have been obvious to modify Krisbergh to Lancelot. Although not clear, it appears that Examiner contends that it would have been obvious to modify Krisbergh with Lancelot's purported teaching of independently transmitting a data signal downstream independent of a TV signal.

However, it is axiomatic that if a proposed modification would render a prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See, MPEP 2143.01, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1964). Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See, MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Here, Krisbergh discloses a method of transmitting data to a terminal by inserting the data signal in a VBI of the TV video signal for purposes of displaying the data on a display device associated with the terminal. This is the basis of the Krisbergh protocol and Krisbergh cites advantages to such downstream data transmission (see, e.g., Col. 8, lines 1-34). Examiner's proposed modification of Krisbergh (not including data in the VBI of the TV signal) would fundamentally change the principle and purpose of the Krisbergh system, which renders the obviousness rejections deficient on their face.

The Examiner contend on Page 3 of the Office Action that:

*the combination of Krisbergh and Lancelot would not change the principle and purpose of the Krisbergh System because the change would further increase the amount of data that Krisbergh system can be transmitted downstream on separate/independent channel.*

However, this contention misses the point and fails to address Applicants' above argument - Examiner's proposed modification of Krisbergh (not including data in the VBI of the TV signal) would fundamentally change the principle and purpose of the Krisbergh system, which renders the obviousness rejections deficient on their face. Again, Lancelot discloses that a TV signal is transmitted with other signals (via combiner (104)) on the HFC communications system (103), and that CACS (cable access signaling) is used for transmission and reception of data, etc. over communication channel (103) at radio frequencies compatible with cable television CATV networks (see, Col. 4, lines 45-66, and Col. 5, lines 45-55. In this regard, Lancelot is yet another example of using communications over low bandwidth cable networks, which is distinguished from the claimed inventions

Applicants respectfully submit that claim 36 is patentable and non-obvious over the combination of Krisbergh, Lancelot and Yasuki for reasons similar to that given above for claim


1. Indeed, Yasuki does not cure the deficiencies of Krisbergh and Lancelot. Accordingly, for at least the above reasons, claims 1 and 36 (and all claims that depend therefrom) are patentable over the cited art of record.

### **Drawing Objections**

The Examiner object to FIG. 2 for the reasons set forth on pages 3-4 of the Office Action. The basis for this objection is unclear, and as such is respectfully traversed. The Examiner seems to suggest that there must be some literal correspondence between claim language and drawings. However, there is no legal requirement for this. In any event, it is abundantly clear that the communication units (104) illustrated in FIGs. 1 and 2 provide clear, express support for the claim terms first and second data processing units in the context of the claimed inventions. The elements 104/106a connected to television set (102) provide clear support for the claimed *“first communication system, operatively coupled to a television set, comprising a first RF transceiver unit and a first data processing unit ..”*

Moreover, the Examiner should note that a bidirectional I/O arrow is depicted between elements (104) and (106) in both FIGs. 1 and 2 and that FIG. 2 is an illustrative embodiment of a first communication system (104),(106a) *(which comprise an RF transceiver (106a) and a data processing unit (104))* coupled to a TV set (102). In short, the basis for the drawing objection is unclear and must be clarified or otherwise withdrawn.

Respectfully submitted,

  
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